THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

_____

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

_____

Ex parte KARL REUTER

_____

Appeal No. 95-1183
Application No. 07/991,693[1]

_____

ON BRIEF

_____

Before GARRIS, PAK and OWENS, Administrative Patent Judges.

GARRIS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the final rejection of claims 1 through 20 which are all of the claims in the application.

[1] Application for patent filed December 16, 1992.

The subject matter on appeal relates to a process for separating a desired substance from an aggregate mixture. This appealed subject matter is adequately illustrated by independent claim 1, a copy of which taken from the appellant's Specification is appended to this decision.

All of the appealed claims stand rejected under the first and second paragraphs of 35 U.S.C. § 112 as the claimed invention is not described in such full, clear, concise and exact terms as to enable any person skilled in the art to make and use the same, and/or for failing to particularly point out and distinctly claim the subject matter which the appellant regards as the invention.

We refer to the Brief and to the Answer for a complete exposition of the opposing viewpoints expressed by the appellant and the examiner concerning the above noted rejections.

OPINION

For the reasons set forth below, neither of these rejections can be sustained.

The § 112, Second Paragraph, Rejection

We first consider the examiner's § 112, second paragraph, rejection for the reasons fully detailed in the case of In re Moore, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971). For

the most part, the examiner's indefiniteness position is based upon her concern that the appealed claim language, including the language "desired substance" in claim 1, "agent" in claim 5 and "organic compound" in claim 6, is "unduly broad" (e.g., see pages 5 and 6 of the Answer). It is well settled, however, that breadth is not indefiniteness. In re Gardner, 427 F.2d 786, 788, 166 USPQ 138, 140 (CCPA 1970). In addition, we discern no legal or scientific basis for the examiner's belief that claim 7 is indefinite because the compounds thereof are described by a common name rather than by, for example, a chemical structure.

In short, when the claim language is properly read in light of the specification as it would be interpreted by one of ordinary skill in the art (In re Moore, id.), it is clear that the definiteness and particularity requirements in the second paragraph of § 112 are satisfied. It follows that we cannot sustain the examiner's § 112, second paragraph, rejection of claims 1 through 20.

The § 112, First Paragraph, Rejection

In essence, this rejection is based upon the examiner's belief that "language is so broad that it causes claim to have a potential scope of protection beyond that which is justified by specification disclosure" (Answer, page 5). It has been long

established that broad language is not offensive to the first paragraph of § 112 unless there is reason to doubt the presumed objective truth of statements contained in the specification disclosure which must be relied on for enabling support. In re Marzocchi, 439 F.2d 220, 223, 169 USPQ 367, 369 (CCPA 1971). Moreover, the examiner's burden of proof in rejecting claims for nonenablement requires acceptable evidence or reasoning which is inconsistent with enablement. In re Strahivelitz, 668 F.2d 1229, 1232, 212 USPQ 561, 563 (CCPA 1982).

On this appeal, the examiner has advanced no evidence or reasoning which adequately supports her nonenablement position. Instead, it is the examiner's essential argument that the appealed claims are unjustifiably broad and should be limited to the appellant's "preferred embodiment" (Answer, page 9). We cannot agree. To demand that the first to disclose shall limit his claims to what he has found will work or to materials which meet the guidelines specified for "preferred" materials in a process such as the one herein involved would not serve the constitutional purpose of promoting progress in the useful arts. In re Goffe, 542 F.2d 564, 567, 191 USPQ 429, 431 (CCPA 1976).

Under the circumstances discussed above, it is clear to us that the examiner has failed to carry her burden of establishing a prima facie case of nonenablement and correspondingly that her § 112, first paragraph, rejection of claims 1 through 20 cannot be sustained[2].

SUMMARY

In conclusion, it is our determination that we cannot sustain either the § 112, first paragraph, rejection or the § 112, second paragraph, rejection of the appealed claims for the reasons set forth above and generally discussed in the case of In re Johnson, 558 F.2d 1008, 194 USPQ 187 (CCPA 1977).

[2] The examiner's comments in the "Response to argument" section of her Answer questioning the utility of products resulting from the here claimed process have no discernible probative value.

The decision of the examiner is reversed.

REVERSED

BRADLEY R. GARRIS Administrative Patent Judge	
CHUNG K. PAK Administrative Patent Judge	BOARD OF PATENT APPEALS AND INTERFERENCES
TERRY J. OWENS Administrative Patent Judge	

Appeal No. 95-1183
Application No. 07/991,693

Bruce J. Boggs, Jr.
Burns, Doane, Swecker and Mathis
P.O. Box 1404
Alexandria, VA 22313-1404

APPENDIX

1. A process for separating a desired substance from an aggregate mixture comprising

forming a three phase system, the first phase comprising the aggregate mixture, the second phase being liquid and comprising a transport phase, and the third phase comprising a surface upon which the desired substance can crystallise, whereby a chemical potential exists for crystal growth of the desired substance in the third phase of the system, thereby creating a flow of the desired substance from the first phase through the second phase to the third phase, where the desired substance crystallises and whereby an equilibrium of the activities of the remaining substances in the aggregate mixture is maintained between the first and the second phase.